

Remarks

In response to the Office Action dated February 20, 2008, Applicant respectfully requests reconsideration based on the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance. Claims 1, 2, 15 and 17 have been amended to correct matters of form.

Interview Summary

A telephone interview was conducted on May 12 between the undersigned and Examiner Dang. During the interview amendments to cure the claim objections and 112 rejections were discussed. It was agreed that any changes were minor and formal and would not require an additional search.

It was further discussed that there was no motivation to combine Desai with any combination of the other references as Desai teaches away from an e-mail server that carries out any function other than as a simple e-mail database. The Examiner requested written arguments for her consideration.

Claim Objections

Independent claim 17 is objected to for using the term “for” indicating intended use. Independent claim 17 has been amended to delete the term “for”. As such, the objection may be withdrawn.

Claim Rejections – 35 U.S.C. §112

Claims 2 and 15 stand rejected under 35 U.C.S. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. Specifically, the rejection is directed to the lack of proper antecedent basis for the recitation “an e-mail”.

Applicant respectfully points out that the antecedent basis as written is correct in that “an e-mail” is being introduced for the first time in both claims 2 and 15. Any previous use of the term “e-mail” does not refer to a particular e-mail but to a mode of communication. As such, the rejection may be withdrawn.

Claim Rejections - 35 U.S.C. §103

Claims 1-3 and 8-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Pfleging (U.S. Pat. App. 20040064445) in view of Matsuo (U.S. Pat. App. 20030130857) in view of Hill (U.S. 6,029,192) and further in view of Desai (U.S. Pat. 6,820,204). Applicant respectfully traverses the rejections.

Independent claim 1 recites, in pertinent part:

“[a] method for retrieving information in a private database...comprising:
at an e-mail server,

upon receiving the request, comparing an e-mail address identified with the wireless communication device against a list of e-mail addresses residing at the e-mail server, and if the identified e-mail address is on the list, then authorizing retrieval from the private database...receiving a response to the query, wherein the response includes the information, wherein the information comprises a list of documents which are listed by order of relevance...”

The Office Action rejects amended independent claim 1 by asserting that Pfleging describes most of the claim elements but concedes that Pfleging fails to describe “at an e-mail server...upon receiving the request, comparing an e-mail address identified with the wireless communication device against a list of e-mail addresses residing at the e-mail server, and if the identified e-mail address is on the list, then authorizing retrieval from the private database... receiving a response to the query, wherein the response includes the information, wherein the information comprises a list of documents which are listed by order of relevance...”.

The Office Action proceeds by asserting that Matsuo describes “...upon receiving the request, comparing an e-mail address identified with the wireless communication device against a list of e-mail addresses residing at the e-mail server, and if the identified e-mail address is on the list, then authorizing retrieval from the private database...”. The Office Action then concedes that the combination of Pfleging and Matsuo fails to describe “at an e-mail server... receiving a response to the query, wherein the response includes the information, wherein the information comprises a list of documents which are listed by order of relevance...”

The Office Action proceeds further by asserting that Hill describes “...receiving a response to the query, wherein the response includes the information, wherein the information comprises a list of documents which are listed by order of relevance...”. However, **the Office Action concedes that the combination of Pfleging, Matsuo and Hill fails to describe “at an e-mail server...”**. The Office Action finally concludes by asserting that Desai cures the

conceded deficiency in the combination of Pfleging, Matsuo and Hill by merely mentioning an e-mail server.

Applicant respectfully points out that in ascertaining the differences between the prior art and the claim at issue requires interpreting the claim and the prior art references each as a whole. (MPEP §2111-2116.01; 2141.02). Further, the prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. (MPEP 2141.02) The question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.

Applicant respectfully asserts that, taking the claim and the references as a whole, there would have been no motivation for one of ordinary skill in the art to combine Desai with Pfleging, Matsuo or Hill because Desai teaches away from the claim elements. The Office Action relies on Desai as describing that all of the other component claim elements occur “at an e-mail server” since the Office Action concedes that the combination of Pfleging, Matsuo and Hill fails to describe such a feature. The Office Action specifically cites Fig. 1, item 30 and column 10, l. 44-45 as describing an e-mail server.

However, considering Desai as a whole, Desai actually describes that the e-mail server 30 is one that is unaffiliated with any other functions of the Desai information exchange system 10 and merely contains an e-mail data storage, an external personal calendar database and/or an external file system. The information exchange system 10 of Desai merely looks for new e-mail from the e-mail server 30 on a periodic basis. (Col. 10, l. 43-61). Since the e-mail server 30 of Desai performs none of the core activities of the Desai information exchange system 10 and is described as merely an unaffiliated e-mail database (Col. 10 l. 43-45), Desai is teaching away from the claim that, when considered as a whole, recites that the claimed functions all occur at the e-mail server.

Further, combining Desai with the combination of Pfleging, Matsuo and Hill would require a change in the principal of operation of Desai since none of the core functions of the information exchange system 10 in Desai are carried out by the cited e-mail server 30. (MPEP 2143.02). Such a combination would require a substantial re-design of the Desai e-mail server 30 and/or a change in the principal under which the e-mail server 30 was designed to operate. Therefore, considering the claim and the references each as a whole, there is no motivation to

combine Desai with the combination of Pfleging, Matsuo and Hill. As such, a *prima facie* case of obviousness has not been established and the rejection must fail for at least these reasons.

Further the combination of Pfleging, Matsuo, Hill and Desai fails to describe each and every claim element. For example, considering the claim as a whole, the current combination of references fails to describe “**...at an e-mail server**, receiving, via e-mail, a request...comparing an e-mail address...authorizing retrieval from the private database; sending a query to retrieve the information; receiving a response to the query...sending the information to the wireless communication device; and...denying the request to-retrieve the information.”

On page 5, the Office Action concedes that the combination of Pfleging, Matsuo and Hill fails to describe that such processes occur at an e-mail server. The Office Action then asserts that the mere existence of an unaffiliated e-mail server 30 in Desai cures the conceded discrepancy in the combination of Pfleging, Matsuo and Hill. (Col. 10, l. 43-45).

However, both the claim and the Desai reference must be each considered as a whole. Because Desai clearly describes that the e-mail server 30 is unaffiliated with the information exchange system 10 and performs none of the principal functionality of the information exchange system 10, Desai is not describing that any of the exchange system’s principal processes are being performed “**at an e-mail server**”. Applicant respectfully points out that not a single reference describes an email server performing the claimed functions. Further, when any of the other references are combined, there still is no description or suggestion of an email server providing such functions.

Because Desai expressly teaches away from the claim elements and because the combination of Desai in combination with any or all of Pfleging, Matsuo and/or Hill does not describe an e-mail server performing the claimed functions, Desai does not cure the conceded discrepancy in the combination of Pfleging, Matsuo and Hill. As such, the combination of Pfleging, Matsuo, Hill and Desai fails to describe “**...at an e-mail server...**” conducting any processes other than acting as a mere unaffiliated database. Because the Office Action has failed to establish a *prima facie* case of obviousness for failing to describe each and every claim element, independent claim 1 is allowable over the combination of Pfleging, Matsuo, Hill and Desai for at least this additional and independent reason.

Independent claims 17 and 20 recite similar subject matter and are allowable for at least the same reasons. Claims 2-3, 8-16 and 18-19 depend from an allowable independent claim 1 or 17 and are allowable for at least the same reasons.

Conclusion

In view of the foregoing remarks, this application is now in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is invited to call the Applicant's attorney at the number listed below.

No Fees are believed due. However, please charge any additional fees due or credit any overpayment to Deposit Account No. 50-3025.

Respectfully submitted,

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/Arno T. Naeckel/

Arno Naeckel #56114

Withers & Keys, LLC
P.O. Box 71355
Marietta, GA 30007-1355
(678) 565-4748